

REMARKS

By this amendment, Applicants have amended claims 12, 15-20, 23-24, and 31. As a result, claims 12-31 remain pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the objections and rejections and reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Final Office Action, claims 12-27 and 29-31 are rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by U.S. Patent No. 6,615,234 (Adamske). In order to establish a *prima facie* case of obviousness, the Office must show that (1) every feature is taught or suggested by Adamske; (2) Adamske or generally available knowledge suggests or motivates the modification(s); and (3) one would have a reasonable expectation of success. MPEP 2143. Because the Office fails to establish a *prima facie* case of obviousness, Applicants respectfully request withdrawal of the rejections of claims 12-27 and 29-31 for the following reasons.

With respect to claim 12, the Office cites column 5, line 64 through column 7, line 51 of Adamske as teaching two alternative methods that, when combined, allegedly teach Applicants' claimed invention. Interpreting Adamske only for the purposes of this response, Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23, a user uploads an electronic document from a client computer to a web server (see, e.g., col. 5,

lines 15-16). The electronic document is then converted to a portable printable format on an application translation server (col. 5, lines 18-19). In order to perform the conversion, “the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents.” (col. 5, lines 19-21).

In the second embodiment, discussed from column 6, lines 24-57, “the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server.” (col. 6, lines 34-38). In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing (col. 6, lines 46-49). Subsequently, the user “sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described.” (col. 6, lines 49-52).

In both embodiments discussed in Adamske, a printable version of the electronic document is expressly generated on an application translation server (e.g., col. 5, lines 18-19 and col. 6, lines 49-52). In sharp contrast, under the claimed invention, system software is provided for use on the client, which allows a user to generate a print file on the client and the print file is obtained from the client. Since, without benefit of the hindsight of Applicants’ claimed invention, neither of these features are taught or suggested by Adamske, Applicants respectfully request withdrawal of the rejection of claim 12 as allegedly being obvious in view of Adamske.

With further respect to claim 12, the Office alleges that Adamske discloses the claimed generating a preview of a configured copy of the document on the server based on the print file and the configuration information. In support of its conclusion, the Office again cites column 5,

line 64 through column 7, line 51 of Adamske as allegedly disclosing this feature. However, Adamske discloses creating web-viewable print preview files by converting the converted printable electronic document into a series of graphical preview images. (col. 6, lines 1-7). Subsequently, “[a]fter user 10 verifies the print preview, at operational screen 70 user 10 can select media options..., output handling options..., and destination(s)/recipient(s).” (col. 6, lines 58-62). Consequently, contrary to the Office’s assertion, Adamske fails to disclose, *inter alia*, the claimed generation of a preview based on the print file and configuration information. As a result, Applicants respectfully request withdrawal of the rejection of claim 12 as allegedly being obvious in view of Adamske.

With respect to claim 17, the Office alleges that Adamske discloses the claimed obtaining memo information, printing a customized memo, and delivering steps. In support of its conclusion, the Office cites col. 7, lines 16-56 as allegedly disclosing these features. Applicants note that Adamske’s discussion of a “memo” is limited to “the print job that produces the hard copy document can also include a print out of the packaging instructions selected by the user, a cover sheet, and a shipping label (if applicable).” (col. 7, lines 40-43). To this extent, Adamske lacks any mention of obtaining memo information that is customized for a recipient at each of a plurality of delivery addresses, let alone printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses. Since, without benefit of the hindsight of Applicants’ claimed invention, none of these features are taught or suggested by Adamske, Applicants respectfully request withdrawal of the rejection of claim 17 as allegedly being obvious in view of Adamske.

With respect to claim 20, the Office alleges that Adamske discloses the claimed system software, means for obtaining, and means for generating. Applicants note that the system software, means for obtaining, and means for generating comprise similar features as those discussed above with reference to claim 12. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 12 for each of these features. As a result, Applicants respectfully request withdrawal of the rejection of claim 20 as allegedly being obvious in view of Adamske.

With respect to claim 24, the Office alleges that Adamske discloses the claimed means for obtaining and means for generating. Applicants note that the Office presents similar arguments as those presented with respect to claim 12 in alleging that Adamske discloses these features. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 12 for each of these features. As a result, Applicants respectfully request withdrawal of the rejection of claim 24 as allegedly being obvious in view of Adamske.

With respect to claim 29, the Office alleges that Adamske discloses the claimed program code for communicating the print file to a server and program code for generating. Applicants note that the Office presents similar arguments as those presented with respect to claim 12 in alleging that Adamske discloses these features. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 12 for each of these features. As a result, Applicants respectfully request withdrawal of the rejection of claim 29 as allegedly being obvious in view of Adamske.

With respect to claim 31, the Office alleges that Adamske discloses the claimed program code for obtaining memo information and program code for printing a customized memo.

Applicants note that the Office presents similar arguments as those presented with respect to claim 17 in alleging that Adamske discloses these features. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 17. As a result, Applicants respectfully request withdrawal of the rejection of claim 31 as allegedly being obvious in view of Adamske.

The Office further rejects claim 28 as allegedly being unpatentable over Adamske in view of U.S. Patent No. 5,873,073 (Bresnan). In support of its conclusion, the Office alleges that Adamske discloses the generation of a user interface that includes a preview area for displaying a preview that is based on a print file and configuration information for a document. However, as discussed with reference to claim 12, Adamske's preview is not based on configuration information. To the contrary, the user only selects this information after verifying the print preview (col. 6, lines 58-62). To this extent, Adamske fails to disclose, *inter alia*, the preview area or the configuration area of the claimed invention. As a result, Applicants respectfully request withdrawal of the rejection of claim 28 as allegedly being obvious in view of Adamske.

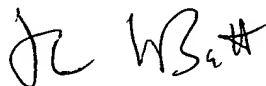
Finally, Applicants note that the Office misinterprets the claimed subject matter of several claims. For example, in rejecting claims 17, 25, and 31, the Office states that "Adamske does not disclose that the customized memo is obtained from the client." However, Applicants note that the claimed subject matter for each of these claims does not include obtaining a customized memo from the client. In fact, claim 25 does not include any reference to a customized memo.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter.

Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "JL WBatt", with a stylized flourish at the end.

John W. LaBatt, Reg. No. 48,301
Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, NY 12207
(518) 449-0044 - Telephone
(518) 449-0047 - Facsimile

Dated: May 18, 2005